

Docket No.: 13173-00009-US
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: Conf. No.: 9675
Martin Klebsattel

Application No.: 10/526,411 Group Art Unit: 1638

Filed: March 2, 2005 Examiner: Brent T. Page

For: TRANSGENIC EXPRESSION CASSETTES
FOR EXPRESSING NUCLEIC ACIDS IN
NONREPRODUCTIVE FLORAL TISSUES OF
PLANTS

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the restriction requirement set forth in the Office Action mailed August 10, 2006, Applicants provisionally elect Group I, claims 1-2 and 14-23, and SEQ ID NO: 1, with traverse. Applicants respectfully traverse and strongly urge reconsideration and withdrawal of the restriction requirement for the following reasons.

Because this application is a national stage filing pursuant to 35 U.S.C. § 371, unity of invention under PCT Rule 13.1 and 13.2 is the applicable standard. Unity of invention is fulfilled “when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical feature. The expression “special technical feature” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.” (PCT Rule 13.2).

The Examiner argues that the inventions of Group I-VI do not relate to a “special technical feature” which defines a contribution over the prior art, citing Takatsuji et al. (1991, The EMBO Journal 11:241-249). Applicants respectfully disagree that the inventions of the present application do not make a contribution over the reference cited by the Examiner.

As stated in the specification and repeated in the claims, the general inventive concept of the present application relates to promoters and methods of identifying and using said promoters which show expression in all floral organs with the exception of the pollen and the ovaries. See specification at page 3, lines 15-17. Furthermore the promoters are active during all of floral development. See specification at page 3, lines 1-7. The Examiner characterizes Takatsuji et al. as disclosing the EPF1 gene which is expressed in the petals of Petunia. Takatsuji et al. does not disclose the promoters of the present invention. Takatsuji et al. does not teach a promoter which shows expression in all floral organs with the exception of the pollen and the ovaries and does not teach a promoter active during all of floral development. Therefore, Takatsuji et al. does not establish the general inventive concept or the special technical feature of the present invention. Accordingly, Applicants respectfully request that the Examiner reconsider the restriction requirement and examine all the claims in one application.

The Examiner has further required an election of a single nucleotide or amino acid sequence, the particular sequence being dependent on the Group elected. Applicants disagree with this requirement and request reconsideration and withdrawal. The sequences are related to each other by sharing a common feature of specificity for nonreproductive floral tissue. Furthermore, as described in the specification on pages 18 (lines 29-39) and 40 (lines 3-17), some of the promoter sequences recited in claim 1 are related to other sequences. For example, SEQ ID NO: 3 is the short version of SEQ ID NO: 1 and SEQ ID NO: 4 is the short version of SEQ ID NO: 2. See, for example, page 40. For these reasons, Applicants respectfully request that the requirement for restriction to one sequence be reconsidered and removed entirely. In the alternative, Applicants respectfully request that at least provisionally elected SEQ ID NO: 1 be examined together with its shorter version, SEQ ID NO: 3.

Furthermore, unity of invention was found during the International stage between Groups I, II, V and VI. As shown in the International Preliminary Examination Report and International Search Report, all claims of Groups I, II, V and VI were searched and examined together. Thus, application of PCT Rules 13.1 and 13.2 by the International Examiners shows that unity exists for at least Groups I, II, V and VI.

Additionally, Applicants believe that there is no undue burden on the Examiner to search and examine at least Groups I, II, V and VI. As previously noted, this is a national stage

application from a PCT application, and Groups I, II, V and VI were searched by the International Search Authority and the International Examination Authority. Applicants respectfully submit that the restriction requirement should be withdrawn even under restriction practice. As stated in § 803 of the M.P.E.P. “[i]f the search and examination of the entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” (M.P.E.P. § 803, emphasis added). Since the search has already been conducted by the International Search Authority and the International Examination Authority for Groups I, II, V and VI and no lack of unity of invention has been found for those groups, there would be no undue burden on the Examiner to examine at least Groups I, II, V and VI in one application.

Conclusion

For the above reasons, Applicants respectfully request that the restriction requirement be reconsidered and withdrawn. Alternatively, Applicants respectfully request that at least SEQ ID NO: 1 and 3 be examined together.

Applicants reserve all rights to pursue the non-elected species in one or more divisional application, if necessary.

Accompanying this response is a petition for a one-month extension of time to respond to the Office Action mailed August 10, 2006 with the required fee authorization. No further fee is believed due. However, if any additional fee is due, the Director is hereby authorized to charge our Deposit Account No. 03-2775, under Order No. 13173-00009-US from which the undersigned is authorized to draw.

Respectfully submitted,

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